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EXAMINER

CHIN, CHRISTOPHER L

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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/381,561
Filing Date: September 17, 1999
Appellant(s): JACKSON, JAMES RICHARD

MAILED

JUL 27 2007

GROUP 1600

David A. Jackson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/30/03 appealing from the Office action
mailed 2/1/02.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

The Notice of Non-Compliant Appeal Brief dated 2/9/07 is withdrawn. The appeal brief filed on 4/30/03 is fine.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,955,028

Chow

9-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

- The 103 rejection over Hillman et al in view of Galen et al or Phillips et al is withdrawn.

- Claims 20-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Chow.

Chow (US Patent 5,955,028) discloses a base unit (12) and adapter (14) to interface an assay substrate (16) with a recording device, such as a computer, to control, record, and/or analyze the data from the assay substrate (col. 5, line 25, to col. 6, line 50). A computer port (24) is provided for mating with conventional serial or parallel inputs on general purpose computers. Usually, the base unit (12) will include at least signal processing and conditioning components, such as analog-to-digital

converters for receiving analog data from adapter (14) and converting that data to digital form for transmission to the computer. Adapter (14) may also include internal microprocessor(s) for further data manipulation (col. 11, lines 1-26). The assay substrate comprises a plurality of sample and reagent wells connected with microchannels (col. 11, line 48, to col. 12, line 6; and Figure 1).

Chow discloses an assay substrate (assay part) that is removable from a computer (recording part). Therefore, Chow anticipates the invention as claimed.

(10) Response to Argument

a.) In response to the 102(e) rejection over Chow, Appellants argue that the computer in Chow is not a detachable recording part that "only records the said assay information without analyzation thereof in a form suitable for onward transmission for subsequent processing and analysis at a remote data site" as recited in claim 20. An advantage of the present invention is that analysis is not part of the device, so as to reduce costs, size, and make the device usable at remote location where a patient could simply send the detachable recording part to a remote site for subsequent processing. This feature contrasts with a personal computer attached to the base unit.

With respect to the recording part in claim 20, claim 20 requires that the recording part be

"detachable from said assay part for storage of assay information generated by said assay part"

and

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"said recording part is in data communication with said assay part when attached to said assay part to enable transfer of assay information from said assay part to said recording part for storage".

Contrary to Appellant's argument, the computer in Chow reads on the recording part of the instant invention since it is detachable, can record assay data, and is in data communication with the assay part through the base unit (12) and adapter (14). With respect to the "wherein" clause in the last part of claim 20, at best the language therein is considered a functional limitation and the computer in Chow can record assay data without further analysis of the data, i.e. is capable of performing the function recited in the "wherein" clause. And at worst the language therein is considered an intended use, which is not given any weight since the claims are directed to an apparatus. With respect to the advantages cited by Appellants, these are at best secondary considerations that carry no weight since Appellants have not provided any evidence to show that the instant invention provides advantages of reductions in cost, size, and convenience versus other comparable testing devices.

b.) Appellants also argue that the computer in Chow is stationary and it is the adapter (14) that is removable from the base unit (12).

First of all, the computer in Chow is not stationary in the conventional sense of the term. The computer in Chow is not immobilized. Second the instant claims only require the recording part be detachable from the assay part. The computer in Chow is detachable from the assay part. Also, Appellants argument that the adapter (14) is removable and not the computer suggests that Appellant are equating the adapter (14)

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to the recording part of the instant invention. If so, it should be noted that the adapter (14) in Chow can include an internal microprocessor(s) (col. 11, lines 13-14). Instant claim 25 defines the recording part as a microprocessor. Thus, adapter (14) could also read on the recording part since it too is detachable from the assay part and can record data from the assay part.

c.) In the paragraph bridging pages 7-8 of the appeal brief, Appellants argue that the Examiner's position that Appellants are arguing intended uses is flawed and refer to claim 21 for support.

Contrary to Appellant's arguments, analysis of data on site (as in Chow) or at a site other than where the data is collected (instant invention) is an intended use. Where the data is analyzed does not further limit the claimed device and thus cannot be considered a claim limitation. The location where data is analyzed does not provide any structural limitation to the claimed device.

With respect to claim 21, the Examiner agrees that the claim does not recite an intended use. However, since the claim does not specify a size, the computer in Chow satisfies the requirements recited in the claim. Computers are not so large that they can't be handled by a single user or technician or transported by a courier.

d.) With respect to claim 38, Appellants argue that Chow fails to recite a step where sample is applied to at least one sample application well of an assay part.

Appellant's attention is directed to column 2, lines 55-65, which specifically teaches that the assay part receives test samples. As shown in Figure 1, the assay part (16) contains wells (60) that receive the test samples.

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e.) With respect to claim 39, Appellants argue that Chow fails to disclose a kit comprising an assessment device, assay reagents and protective packaging for transport to the recording device to a processing facility.

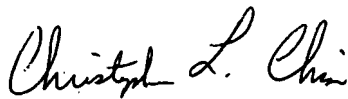
Chow discloses all of the components recited in claim 39 and thus constitutes a kit. With respect to protective packaging for the recording device, the computer is Chow is enclosed in a housing. Since the claim does not recite any specific protective packaging, the housing of the computer in Chow reads on the protective packaging.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

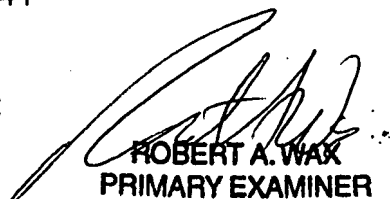
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Christopher L. Chin
Primary Examiner
Art Unit 1641

Conferees:



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